

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the present amendments and the following remarks. By this amendment, claims 4, 7-9, 14, 15, 20, 23 and 24 are amended, and claims 1-3, 6, 18, 19, 22 and 45-50 are canceled. As a result, upon entry of this amendment claims 4, 7-17, 20, 21 and 23-44 are pending in this case, with claims 4, 7, 8, 14, 15, 20, 23, 24, 27 and 36 being independent claims, and claims 27-44 having been previously withdrawn from prosecution in response to a restriction requirement. This amendment is accompanied by a check in the amount of \$1,120.00 for the requisite fees for the net addition of five independent claims and for a one-month extension of time. It is believed that no fees in addition to the fee for a one-month extension of time are due for the consideration of this paper. However, if additional fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Applicants' Interview Summary Record

On June 14, 2005, applicants' attorney, Scott E. Baxendale, conducted a telephonic interview with Examiner Mendiratta regarding the present application and the Examiner's bases for rejection of several of the pending claims. Mr. Baxendale and the applicants again thank Examiner Mendiratta for his time and consideration in granting this telephonic interview after final rejection.

Mr. Baxendale and Examiner Mendiratta first discussed claims 4 and 20 that each recite, *inter alia*, game pieces providing both visual and audible indications of the distance of movement over the surface. Mr. Baxendale pointed out that the rejection of claim 4 in the final Office action presented conclusory statements regarding a motivation for combining the visual indicator game piece and the audible indicator game piece of Potter, but did not provide actual evidence of such a motivation from Potter or any other reference. Mr. Baxendale reminded Examiner Mendiratta that the M.P.E.P. and case law precedent require a showing of actual evidence of a suggestion or motivation to combine in order to establish a *prima facie* case of obviousness. Mr. Baxendale further pointed out that, in contrast to the Examiner's Response to Arguments regarding the rejection of claim 4 on page 4 of the final

Office action, observing the movement of the game piece with audible distance indication of Fig. 11B of Potter was not the same as providing a game figure and a visual distance indicating device as recited in the claims. Agreement was not reached on these claims, but Examiner Mendiratta indicated that he would note the applicants' position and consider it when evaluating the applicants' response to the final Office action.

Examiner Mendiratta and Mr. Baxendale next discussed the rejections of claims 7 and 23 directed to providing a spring-loaded projectile launcher in a game piece having a distance measuring device. Mr. Baxendale pointed out that this rejection also relies on the conclusory assertions of the Examiner regarding a motivation to combine Potter and Andrews *et al.* because toy weapons attract people in toy stores. Examiner Mendiratta then referred to Figs. 13C and 13D of Potter for the proposition that biasing of the arm 171 was shown by Potter even though no spring or other biasing element was shown or taught by Potter. Mr. Baxendale responded that Potter only teaches operating the arm 171 by pressing down on the top part 170, and does not teach or suggest modifying the pawn to include a spring or any other biasing element. Agreement was not reached on these claims, but Examiner Mendiratta indicated that he would note the applicants' position and consider it when evaluating the applicants' response to the final Office action.

Next, Examiner Mendiratta and Mr. Baxendale discussed the rejections of claims 8 and 24 directed to the game figure character having first and second portions movable with respect to each other, with a spring engaging the portions and biasing the second portion toward a first position. Mr. Baxendale reasserted the lack of motivation for combining the Potter and Andrews *et al.* references previously discussed with respect to claims 7 and 23. Mr. Baxendale further pointed out that Andrews *et al.* teaches away from a game figure character as recited in claims 8 and 24 because Andrews *et al.* discloses a toy figure 11 having a lower torso 12 and an upper torso 20 with a bi-directional motor and gear drive mechanism to pivot the upper torso 20, and does not suggest replacing or supplementing the motor with a spring to bias the upper torso 20. Agreement was not reached on these claims, but Examiner Mendiratta indicated that he would also note the applicants' position on these claims and consider it when evaluating the applicants' response to the final Office action.

Examiner Mendiratta and Mr. Baxendale then discussed the rejections of claims 14, 17 and 21 reciting a pinion gear engaging a circular rack. Mr. Baxendale asked Examiner Mendiratta to further explain his interpretation of the term “rack” such that the term reads on the belt 239 of Potter. Examiner Mendiratta asserted that the guide lines 240 on the belt 239 in Fig. 10A of Potter were elevated. Mr. Baxendale pointed out that the guide lines 240 are merely markings on the belt 239 and do not extend beyond the outer surface of the belt 239. Examiner Mendiratta noted that, upon further inspection of the Potter drawing figures, he no longer thinks that the guide lines 240 are elevated, and conceded that Potter does not disclose a rack. Examiner Mendiratta indicated that he would note that fact and consider it when evaluating the applicants’ response to the final Office action.

Examiner Mendiratta and Mr. Baxendale also discussed the rejections of claims 15 and 25 reciting display devices alternately displaying and shielding indicium indicative of a special characteristic of the game piece. Mr. Baxendale pointed out that Potter only discloses the displaying of indicia indicative of movement of Potter’s game pieces and no other indicia, in particular indicia indicative of special characteristics as recited in the claims. Examiner Mendiratta asserted the position that any markings could be indicia, and that the meaning of the indicia was not limiting. Consequently, Examiner Mendiratta indicated he could read the limitation on the guide lines 240 and numerals 242, 243 relating to distance traveled by the pawn 231 of Potter. Mr. Baxendale disagreed with this assertion. Agreement was not reached on these claims.

Finally, Examiner Mendiratta and Mr. Baxendale discussed the rejection of claim 26 reciting second indicium disposed on a second surface of the rack and a second faceplate having an aperture for alternately displaying the second indicium. Mr. Baxendale referred Examiner Mendiratta to the drawing figures of the present application showing second face plate 56 with visual aperture 58 alternately displaying the red marks 52 on the lower surface 30b of the rack 30. Examiner Mendiratta indicated that he would note that fact and consider it when evaluating the applicants’ response to the final Office action.

Claim Amendments

Claims 4, 7, 8, 14, 15, 20, 23 and 24 have been rewritten in independent form including all the limitations of the corresponding independent claims and any intervening claims. Claim 9 is amended in light of the cancellation of claim 1 to depend from claim 7. Claims 1-3, 6, 18, 19, 22 and 45-50 are canceled. Applicants respectfully submit that the amendments to the claims do not present new matter and do not raise new issues, and respectfully request entry of the present amendments and consideration of the claims as amended.

Claim Rejection Under 35 U.S.C. § 102(b) and 103(a)

Claims 1-3, 6, 9-13, 15-22, 25, 26 and 45-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Potter (U.S. Patent No. 2,052,035), claims 4 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Potter, and claims 7, 8, 23 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Potter in view of Andrews *et al.* (U.S. Publication No. 2003/0220044 A1). Applicants respectfully request reconsideration of remaining claims 4, 7-17, 20, 21 and 23-26 in view of the discussion during the telephonic interview and the following additional remarks.

Referring first to claims rejected in view of Potter alone, claims 4 and 20 recite action figure game pieces having a device or devices providing both visual and audible indications of the distance the game figure piece moves over a surface. As admitted by the Examiner in the final Office action and during the telephonic interview, Potter does not disclose an embodiment having a pawn with both visual and audible indications of distance. Moreover, Potter provides no suggestion or motivation for combining the embodiments in a single pawn having both visual and audible indications of distance. The Examiner provides a conclusory assertion regarding combining the two embodiments so that people with normal vision and visually challenged individuals may both play Potter's game, but does not provide any actual evidence of such teaching in Potter. In fact, in the Examiner's Response to Arguments at page 4 of the final Office action, the Examiner admits that Potter does not provide motivation for visual and audible distance indications in the same embodiment. The only suggestion of such a combination is provided in Applicants' own disclosure, the use of which constitutes impermissible hindsight analysis. *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q.

193, 199 (Fed. Cir. 1983) (It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.). It is clear that the prior art must make a suggestion of or provide an incentive for the claimed combination of elements for the examiner to be able to establish a *prima facie* case of obviousness. See, *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). In the Response to Arguments, the Examiner further asserts that observation of the movement of the piece with the clicker of Fig. 11B provides a visual indication of distance. However, claims 4 and 20 recite that the game pieces include game figure characters and devices providing a visual indication of distance moved across the surface. Therefore, the mere observation of the movement the game figure character does not anticipate the limitation of a visual indication device in addition to the game figure character. Because Potter fails to disclose or suggest combining the audible and visual pawn embodiments in a single pawn, and the Examiner has not cited any other reference providing a suggestion or motivation for such a combination, it follows that Potter cannot render claims 4 and 20 obvious.

Regarding claims 14, 17 and 21, applicants respectfully submit that Potter does not disclose or suggest an action figure game piece having a distance measuring device having a pinion gear engaging a circular rack as recited in the claims. During the telephonic interview, the Examiner acknowledged that neither the belt 239 nor any other component in Potter is a rack, let alone a rack engaged by a pinion. Moreover, Potter does not suggest substituting a rack and pinion arrangement for the cylinder 237 and belt 239. Consequently, applicants respectfully request the withdrawal of the rejection of claims 14, 17 and 21 in view of Potter.

Claims 15 and 25 recite action figure game piece having a distance measuring device and a display device alternately displaying and shielding indicium indicative of a special characteristic of the game piece. Applicants respectfully reassert their previously-stated position that Potter discloses distance indicia, but does not disclose or suggest either special characteristic indicium for the game piece or the alternate displaying and shielding of such indicium. Applicants respectfully disagree with the contention of the Examiner in the telephonic interview that "indicium" can mean any indicia, with the implication that the phrase "indicative of a special characteristic of the game piece" is given no weight in

determining patentability. Each claim recites that the game piece includes both a distance indication device **and** indicia indicative of a special characteristic. Consequently, the special characteristic indicia is something other than that which provides the distance indication. Potter only discloses indicia (guide lines 240 and numerals 242, 243) that are indicative of distance. Therefore, because the special characteristic indicia are not distance indicating indicia, and the Potter only teaches alternately displaying distance indicating indicia, it follows that Potter does not anticipate or render obvious claims 15 and 25.

Turning to the rejections of claims 7, 8, 23 and 24 over Potter in view of Andrews *et al.*, applicants reassert the position of their previous response and expressed in the telephonic interview that the Examiner has not established a *prima facie* case of obviousness by failing to provide actual evidence of a suggestion or motivation to combine the references in the manner proposed by the Examiner. In order to establish a *prima facie* case of obviousness, there must be **actual evidence** of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be **clear and particular**. See, e.g., *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (“We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not ‘evidence.’**”) (emphasis added, citations omitted). The mere fact that references *can* be modified is *not* sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)” (emphasis original).

The Examiner reasserts his prior conclusory statements that such launchers simulate real weapons and attract people, and therefore one of ordinary skill in the art “would have suggested” providing such a launcher with the pawns of Potter. Applicants respectfully reassert that these statements do not satisfy the requirement of a clear and particular showing

of actual evidence of a suggestion or motivation for the proposed combination. Moreover, the references do not provide the necessary suggestion or motivation. Potter discloses an arm 171 for tossing or kicking a ball “by quickly tapping the top part 170 with a downward motion of the player’s finger thus causing the cup shaped device to swing outward and upward.” (Potter, page 5, second column, lines 15-23). Contrary to the Examiner’s contention during the interview, Potter does not show biasing of the arm 171, and does not suggest adding a spring or other biasing device to the disclosed pawns. Andrews *et al.* discloses projectile launchers, but neither Potter nor Andrews *et al.* suggest the desirability of the combination. Because the Examiner has failed to provide the required actual evidence of a suggestion or motivation for the proposed combination, and the references themselves do not provide the necessary suggestion or motivation, it follows that claims 7, 8, 23 and 24 are not rendered obvious by the Potter and Andrews *et al.* references.

Regarding claims 8 and 24, Potter and Andrews *et al.* do not teach or suggest a game figure character having first and second portions, with the second portion of the game figure character being moveably connected to a first portion of the character mounted to the base with a spring engaging the portions and biasing the second portion to engage an adjacent game piece as recited in the claims. As discussed above, Potter does not disclose or suggest providing a spring or any other biasing element in the pawns. Andrews *et al.* discloses spring-loaded projectile launchers, but does not disclose the toy figure 10 having a spring biasing portions of the toy figure that are moveable relative to each other. A lower torso 12 and an upper torso 20 of the toy figure 10 are joined in a pivotal motor driven attachment to allow the upper torso to be rotated by the motor to aim the weapon launchers. Andrews *et al.* does not suggest replacing the motor with a spring engaging the lower and upper torsos 12, 20, respectively, and the use of the motor and gear drive mechanism teaches away from the use of a spring to bias the upper torso 20 toward a particular position. For these additional reasons, the Potter and Andrews *et al.* references do not disclose or suggest first and second portions of a game figure character and accompanying spring as recited in claims 8 and 24 and, consequently, do not render claims 8 and 24 obvious.

Entry and consideration of the foregoing amendments as improving the form of the application are solicited. The amendments have the effect of narrowing the issues for

consideration by Examiner Mendiratta, or on appeal, and were not earlier presented because, prior to the final Office action and Examiner Mendiratta's comments therewith, these amendments were not felt necessary to obtain allowance.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

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